

Application No.: 10/729,114

Docket No.: 59098US002

**REMARKS**

The Final Office Action dated June 12, 2008 has been received and reviewed. Claims 1, 19, and 20 having been amended, claims 26-28 having been added, claims 1-28 are pending in the application. Withdrawal of the rejections are respectfully requested.

The amended and new claims are fully supported by the originally filed application, for example, at page 3, line 27 through page 4, line 2, and page 4, lines 18-24.

**Double Patenting Rejection**

Claims 1-25 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-73 of co-pending Application No. 10/728,577. Upon an indication of otherwise allowable subject matter and in the event this rejection is maintained, Applicants will provide an appropriate response.

**Rejection under 35 USC §102**

The Examiner rejected claims 1-6, 13-18, 21, 24, and 25 under 35 U.S.C. §102(b) as being anticipated by WO 02/066087 ('087). This rejection is respectfully traversed.

Applicants' claims are directed to a nonadherent polymer composition. This is not merely a statement of intended use; rather, the components (polymer matrix, optional plasticizing agent, and microparticles) are selected and combined in amounts to form an absorbent, nonadherent polymer composition. Applicants have further clarified the invention by amending claims 1, 19, and 20 to recite that nonadherent polymer composition when coated on a substrate displays a 180° peel strength from stainless steel of less than 1 N/cm.

There is no teaching or suggestion in WO 02/066087 to make a nonadherent polymer composition. WO 02/066087 is drawn specifically to an adhesive composition. It is respectfully submitted that although a definition per se may not be provided in WO 02/066087, one of skill in the art would clearly understand that the compositions of WO 02/066087 are adhesives that "must provide sufficient adhesive strength to adhere the microcolloid containing composition of the invention to the skin of the user" (page 17, paragraph 1). Furthermore, WO 02/066087 provides data that demonstrates the compositions of WO 02/066087 adhere to steel. The 90° peel from steel plates is provided for an example of the invention (A1) in Table 5. This value is 14.2 N per 25 mm, which calculates (x 10 mm/1 cm) to 5.7 N/cm. It is respectfully submitted that although Applicants' claims recite a value of 180° peel from

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stainless steel, 90° peel values are generally lower than 180° peel values. For example, from stainless steel, the 90° peel values are about 70% of the 180° peel values (see, for example, Exhibit A: page 2 of <http://www.safetylabel.com/pdfs/3m7908.pdf>).

Stainless steel is a standard peel surface and is regularly used for testing pressure sensitive adhesive adhesion (Exhibit B: British Pharmacopoeia Appendix XX H, HMSO, London, 1988). A strong correlation between the adhesion to steel plate and adhesion to skin was noted in pressure sensitive adhesive cosmetic patches (Exhibit C: H. Mahdavi et al., Indian Journal of Dermatology, Venereology and Leprology, Vol. 72, No. 6, November-December, 2006, pp. 432-436). While no substrate exactly mimics skin, stainless steel has the best ability to distinguish among the medical tapes. Overall, for quality control purposes (yielding good discrimination and precision), stainless steel is the optimal substrate, according to Exhibit D: AM Wokovich et al., Biomed Mater Res B Appl Biomater., Published online Apr 3, 2008.

Thus, although Applicants' invention may use hydrophilic microparticles for absorbency, the polymer matrix of Applicants' invention is not an adhesive. Applicants' polymer composition per se is nonadherent. At page 10 of the Office Action, the Examiner stated that "[t]he claims' language does not exclude the presence of other ingredients including adhesive polymers disclosed by [sic] the reference." It is not clear how the Examiner is interpreting the claims such that this is a true statement. Clarification is requested. As explained at page 3, line 27 through page 4, line 2 of Applicants' specification, although the composition could be used in combination with a pressure sensitive adhesive, for example, in an article (e.g., a wound dressing), the polymer composition is nonadherent.

Applicants' claim language of an "absorbent, nonadherent polymer composition" is not simply a statement of an intended use; rather, it is a defining feature, particularly now that the claims recite a specific level of nonadhesion to stainless steel. This language contributes to the overall definition of the composition. This defining feature is very different from the composition of WO 02/066087. This defining feature provides guidance as to what components and amounts to select to provide a structural difference to the composition. Simply because the components of Applicants' invention and those of WO 02/066087 may overlap, does not mean that they cannot be combined in different ways to create entirely different resultant compositions – one that is an adhesive and one that is nonadherent.

At page 10 of the Office Action, the Examiner stated that "[a] recitation of the intended use of the claimed invention must result in a structural difference between the claimed

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invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim." Without challenging the Examiner on the foundation and accuracy of these assertions, Applicants submit that there is no requirement in the patent law that such structural difference cannot be expressed in terms of functional language (see, for example, M.P.E.P. §2173.05(g), "A functional limitation is an attempt to define something by what it does, rather than by what it is (e.g., as evidenced by its specific structure or specific ingredients). There is nothing inherently wrong with . . . functional terms"). The structural difference in the Applicants' polymer composition is expressed in Applicants' claims in terms of its function. Applicants' polymer composition is nonadherent, whereas the polymer composition of WO 02/066087 is an adhesive. Applicants request the Examiner to clarify how such an adhesive polymer composition of WO 02/066087 could also be nonadherent and display at 180° peel strength from stainless steel of less than 1 N/cm.

#### **Rejection under 35 USC §103**

The Examiner rejected claims 7 and 8 under 35 U.S.C. §103(a) as being unpatentable over WO 02/066087. The Examiner rejected claims 9-11, 19, and 22 under 35 U.S.C. §103(a) as being unpatentable over WO 02/066087 in view of "SALCARE® SC95" by Ciba®. The Examiner rejected claims 12, 20, and 23 under 35 U.S.C. §103(a) as being unpatentable over WO 02/066087 in view of Brook (U.S. Patent No. 4,902,565). These rejections are respectfully traversed.

As discussed above, Applicants' claims are directed to a nonadherent polymer composition. The components (polymer matrix, optional plasticizing agent, and microparticles) are selected and combined in amounts to form an absorbent, nonadherent polymer composition. Applicants have further clarified the invention by amending claims 1, 19, and 20 to recite that nonadherent polymer composition when coated on a substrate displays a 180° peel strength from stainless steel of less than 1 N/cm. This is not simply a statement of an intended use; rather, it is a defining feature. This defines a feature of the composition. This defining feature provides a polymer composition that is very different from the composition of WO 02/066087, which is one that is an adhesive, whereas Applicants' claims define a nonadherent polymer composition.

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WO 02/066087 does not disclose any teaching or suggestion of how to modify its composition to be nonadherent per se. Nothing in any of the other cited documents cures the deficiencies of WO 02/066087. Nor is there any motivation provided by any of the other documents cited by the Examiner to use the components of WO 02/066087 to make a nonadherent composition. Additionally, none of the combinations of cited documents provides one skilled in the art with a reasonable expectation of successfully forming an absorbent, nonadherent polymer composition. Thus, none of the cited combinations of documents teaches or suggests all of the features recited in Applicants' claims.

Therefore, Applicants respectfully request reconsideration and withdrawal of the rejections under 35 U.S.C. §102(b) and 35 U.S.C. §103(a).

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Summary

It is respectfully submitted that the pending claims 1-28 are in condition for allowance and notification to that effect is respectfully requested. If a telephonic conference with Applicants' undersigned representative would be useful in advancing the prosecution of the present application, the Examiner is invited to contact the undersigned. A notice of allowance for all pending claims is respectfully solicited.

Respectfully submitted

By

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CERTIFICATE UNDER 37 CFR §1.8:

The undersigned hereby certifies that the Transmittal Letter and the paper(s), as described hereinabove, are being transmitted by facsimile in accordance with 37 CFR §1.6(d) to the Patent and Trademark Office, addressed to Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 9th day of September, 2008, at 8:30am, (Central Time).

By:

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